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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,737	06/01/2001	Thomas A. Soulanille	9623/324	3926

7590 11/04/2003  
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EXAMINER

LE, UYEN T

ART UNIT PAPER NUMBER

2171

DATE MAILED: 11/04/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

4

# Office Action Summary

Application No.

09/872,737

Applicant(s)

SOULANILLE, THOMAS A.

Examiner

Uyen T Le

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's statement regarding the inventorship of this application and application 09/322,677, now US Patent 6,269,361 from which this application is a CIP has been fully considered. Accordingly, the present application is examined as a valid CIP of application 09/322,677.
2. The information disclosure statements filed 25 January 2002 and 14 July 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they do not include copies of the articles cited by the applicant. They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).
3. Applicant's amendment to the specification is acknowledged. Consequently, objection to the specification is withdrawn.

Art Unit: 2171

4. Applicant's explanations and amendment to the drawings have been fully considered. Consequently, objection to the drawings is withdrawn.

5. Applicant stated that the present application and Davis reference were commonly owned at the time the invention was made. Therefore, rejection to claims 1-6 under U.S.C. 103 (a) using Davis is withdrawn.

6. Applicant's arguments regarding the rejection of claims 7-13 under 35 U.S.C. 102(a), (e) have been fully considered. Consequently, rejection to claims 7-13 under 35 U.S.C. 102(a) is withdrawn. However, rejection to claims 7-13 under 35 U.S.C. 102(e) is maintained.

7. Applicant cited portions of the specification to support the claimed "random order weighted", "bid amount-weighted random drawing", "bid rank-weighted random drawing". However, the specification cannot be read into the claims. Consequently, rejection to claims 7-12 under 35 U.S.C. 112, second paragraph is maintained because the order of a listing generally cannot be "random" and "weighted" at the same time.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 2171

applicant regards as the invention. In claims 7-12, the "random order weighted", "bid amount-weighted random drawing", "bid rank-weighted random drawing" are interpreted by the examiner as an order weighted by the bid amount.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 7-13 are rejected under 35 U.S.C. 102 (e) as being anticipated by Davis et al (US 6,269,361).

Regarding claim 7, Davis discloses all the claimed subject matter (see the abstract, column 4, line 51- column 6, line 34). The claimed "receiving a search request from a searcher" is met when Davis shows the search engine for clients to search (see Figure 1, column 10, lines 7-20). The claimed "in a database...match with the search request" is met by the fact that advertisers in the method of Davis bid for a position in the search listing and accounts of advertisers include search terms (see column 5, lines 18-40, column 9, lines 42-45) . The claimed "selecting... searcher" is met by the fact that the method of Davis limits search listings to a geographical area for example (see column 17, lines 19-45). The claimed "arranging...searcher" is met by the fact that the

Art Unit: 2171

search results are displayed according to the bid amount and presented to searchers (see column 5, lines 30-40).

Claim 8 merely reads on the fact that the method of Davis, the highest bid listing is displayed before the lower bid listing (see column 18, lines 4-35).

Claim 9 is met when Davis shows that the listings are ordered by bid amount (see column 5, lines 35-40).

Claims 10-12 merely differ from claims 7-9 above by reciting "bid rank" instead of "bid amount". Davis explicitly shows the claimed bid rank (see column 13, lines 16-20, column 18, lines 4-35).

Claim 13 merely differs from claim 7 by not reciting "selecting no more than a predetermined number of identified search listings". Davis discloses all the claimed subject matter as discussed in claim 7 above.

#### ***Allowable Subject Matter***

10. Claims 1-6 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not disclose or make obvious selecting search listings, each listing associated with an advertiser and a bid amount, for displaying to a searcher in a random order, including all the limitations of claim 1.

Claims 2-6 being further limiting and definite are also allowable.

#### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2171

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Uyen Le  
Primary Examiner  
AU 2171

30 October 2003